



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,849	03/15/2005	Xuanming Shi	05504-PCT	1881
33804	7590	04/01/2009		
LIN & ASSOCIATES INTELLECTUAL PROPERTY, INC.				
P.O. BOX 2339				
SARATOGA, CA 95070-0339				
EXAMINER				
HOLTON, STEVEN E				
ART UNIT		PAPER NUMBER		
2629				
NOTIFICATION DATE		DELIVERY MODE		
04/01/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jason.lin@linassociatesip.com

jasonzlin@gmail.com

### Office Action Summary

**Application No.**

10/527,849

**Applicant(s)**

SHI, XUANMING

**Examiner**

Steven E. Holton

**Art Unit**

2629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 9-11, 16, 19-21, 23, 25 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-11, 16, 19-21, 23, 25 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is made in response to applicant's amendment filed on 2/07/20090. Claims 1-6, 9-11, 16, 19-21, 23, 25, and, 28 are currently pending in the application. An action follows below:

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-6, 9-11, 16, 19-21, 23, 25, and, 28 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant has presented multiple arguments in light of the amendments to the claims.

Regarding the arguments that the presented prior art lacks a single wire forming multiple loops in a single direction as one part of an inductive input layer. The Examiner agrees that the Yamanami reference does teach multiple loops being formed by multiple wires in a single direction. However, the Applicant's specification indicates the use of multiple wires forming loops in a single direction rather than a single wire as amended and argued. Specifically, Figs. 3 and 4 are described as having a wire lattice made of wires winded along X and Y axis depending on the layer (paragraph 50). Therefore, while the proposed amendment overcomes the prior art of record, the amendment is not supported by the specification and is an issue of new matter. At this time a rejection under 35 USC 112 1<sup>st</sup> is being presented based on the issue of new matter with respect to the arguments that only a single wire is used to form all of the loops in a direction in an inductive layer.

Regarding the arguments that the presented prior art lacks a teaching of multiple input layers each comprising an X input layer and a Y input layer with offset windings. The Examiner agrees that the previously presented prior art fails to disclose multiple layers of windings. The Yamanami and Kikuchi references disclose single X and Y layers forming the touch input system and do not teach a plurality of induction layers where each induction layer has a wire layer of loops in one direction and a wire layer of loops in another direction.

The Examiner cites Ely et al. (USPN: 6489899) which discloses an inductive touch system having multiple X and Y loop layers forming the input device (Fig. 4e, elements 41-1 to 41-8 are layers of wiring forming inductive layers in alternating X and Y directions). Logically a pair of X and Y layers (such as elements 41-1 and 42-2) could be defined as a single inductive layer which means that Ely possesses a plurality of inductive layers each having a set of X and Y loops of wire. The Examiner feels the reference is highly pertinent to this application with respect to 35 USC 102 and 103.

Also, the Examiner notes that the US Patent to Shih (USPN: 7486270) is assigned to the same assignee and discloses a very similar invention to the current application. The Examiner notes that the combination of claims 1 and 6 of the Shih patent are closely related to claim 1 of the current application. The Applicant is advised to consider the similarities between these claims with consideration to double patenting issues.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6, 9-11, 16, 19-21, 23, 25, and, 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the claim states, "a single first wire wound on said wire lattice, said first wire being wound with multiple turns to form a plurality of loops..." and "a single second wire interlaced with said first wire, said second wire being wound with multiple turns to form a plurality of loops...". The use of a single loop for forming an entire sensing layer is not disclosed within the specification. The specification recites the use of a sensing layer have a wire lattice made up of wires (Figs. 3 and 4; paragraph 50). This indicates that a sensing layer is not made of a single wire forming all of the loops, but multiple wires used to form multiple loops. There is no teaching within the specification about using a single wire for forming all of the loops within a sensing layer. Therefore, the amendment to the claims regarding using a single first wire and a single second wire for forming the different sensing layers constitutes a new matter issue. Therefore, claim 1 is rejected under 35 USC 112 1st paragraph. Claims

2-6, 9-11, 16, 19-21, 23, 25, and, 28 all depend from claim 1 and therefore are also rejected under 112 1st paragraph.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ely et al. (USPN: 6489899) discloses an inductive touch input system with multiple layers of X and Y wire loops. The wire loops are further displaced from each other so that the wire loops do not completely overlap from one layer to the next. Shih (USPN: 7486270) has the same assignee as the current application and describes a similar multiple layer inductive touch system for whiteboards having multiple inductive input layers having X and Y positioned loops of wire.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven E. Holton whose telephone number is (571)272-7903. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bipin Shalwala/  
Supervisory Patent Examiner, Art Unit 2629

Steven E. Holton  
Art Unit 2629  
March 26, 2009